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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,293	09/01/2004	Andreas Hartbrich	LP-1942	3212
217	7590	08/18/2006		
FISHER, CHRISTEN & SABOL 1725 K STREET, N.W. SUITE 1108 WASHINGTON, DC 20006				
			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/506,293</p>	<p>Applicant(s) HARTBRICH ET AL.</p>	
	<p>Examiner William K. Cheung</p>	<p>Art Unit 1713</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none.
- Claim(s) objected to: none.
- Claim(s) rejected: 1-18.
- Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER


11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


 8/17/06
 WILLIAM K. CHEUNG
 PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that the examiner fails to provide proof that the composition of Shinagawa et al. is substantially identical to the composition of claims 1-18. However, applicants fail to recognize that the examiner has already set forth that Shinagawa et al. (col. 2, line 17-50) disclose a membrane (or film) comprises a polymer that is substantially identical to the one as claimed. Further, Shinagawa et al. (col. 4, line 56-67) disclose that the film can be prepared by dissolving the polyolefin in an organic solvent and casting the solution onto a substrate, and evaporate the solvent away. Since the film of Shinagawa et al. is to be used as a membrane, the examiner believes that the claimed "peeling the film away" feature is inherent to the process of Shinagawa et al. Regarding drying the film at a temperature rising to 70-140 °C, Shinagawa et al. (col. 7, line 35-43) clearly teaching heating the film to 70 °C to remove residual solvent. Regarding the claimed "optical film" feature, in view of the substantially identical composition of Shinagawa et al. and the composition claimed in applicants' process, the examiner has a reasonable basis that the claimed "optical film" feature is inherently possessed in Shinagawa et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980). In response the examiner's office action of May 8, 2006, instead of providing the rationale for why the prior art does not disclose the composition as claimed, applicants continue to request for further proof. In view of lack of response to the final rejection of May 8, 2006, the examiner has a reasonable basis to maintain the rejection of claims 1-18.

Regarding applicants' argument that the recitation "gentle wind or breeze" of Shinagawa et al. (col. 8, line 24-35) can not be considered as "laminar flow" as claimed, applicants fail to recognize that because Shinagawa et al. do not indicate anywhere in the prior art that "gentle wind or breeze" are turbulent flow. Therefore, the examiner has a reasonable basis to believe that claimed "substantially laminar gas flow" is inherently possessed in Shinagawa et al.

Regarding the argued "at least 1 percent by volume of solvent vapor at a temperature below the boiling point of the solvent", applicants must recognize that Shinagawa et al. (col. 4, line 56-67) clearly disclose that the film can be prepared by dissolving the polyolefin in an organic solvent and casting the solution onto a substrate, and evaporate the solvent away. Because Shinagawa et al. disclose that the solvent is being evaporated in a condition that is similar to the condition as claimed, the examiner has a reasonable basis that the claimed "at least 1 percent by volume of solvent vapor at a temperature below the boiling point of the solvent" has been met by Shinagawa et al.



8/17/06
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PRIMARY EXAMINER